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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/674,094

09/29/2003

Laurence J. Cull

P03231

2170

23702

7590

10/29/2007

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EXAMINER

DEAK, LESLIE R

ART UNIT

PAPER NUMBER

3761

MAIL DATE

DELIVERY MODE

10/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/674,094
Filing Date: September 29, 2003
Appellant(s): CULL ET AL.

MAILED

OCT 29 2007

Group 3700

Michael L. Smith
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9 August 2007 appealing from the Office
action mailed 31 January 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4963131	Worrich	10-1990
4,416,772	Sato et al	11-1983

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,963,131 to Worrich in view of US 4,416,772 to Sato et al.

In the specification and figures, Worrich discloses the device substantially as claimed by Appellant. With regard to claim 1, Worrich discloses an elongated connector or waste line 79 that is connected to an ophthalmic pump cartridge 15 that provides a conduit for aspirated matter to flow from the cartridge to waste bag 100 (see FIG 2, column 6, lines 15-18). The connector or waste line is structured to connect to cartridge 15 (see FIG 2) with a second end in bag 100 (see column 6, lines 15-18).

Worrich fails to disclose that the second end of the waste line or connector comprises a notched end. However, Sato discloses an apparatus for removing fluid from a patient comprising a connector line 21 that has a first end connected to a pumping apparatus and a second end positioned within the end of a collection bag 20 (see FIGS 4-5). The connector line 21 has a main body with slit elements or notches 22

disposed at the bag end of the connector line in order to provide a fluid passageway through the connector line 21 even when the bag 20 collapses around the line 21 due to negative pressure within the bag (see column 3, lines 6-25).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the connector line disclosed by Wortrich with a notched end as disclosed by Sato in order to provide a fluid flow pathway through the connector line even when the bag collapses around the connector line, as taught by Sato.

With regard to Appellant's claim limitations drawn to the operation of the notch, such a statement is held by the examiner to be a statement of the intended use of the device. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. See MPEP 2114. In the instant case, the combination of Wortrich and Sato is capable of operating as claimed by Appellant, since Sato teaches that the notched design prevents the bag from sealing against the conduit upon collapse. Appellant's claim language directed to the actions of the surgeon during the surgery fail to set forth any structural limitations that differentiate the structure of the instantly claimed invention from that of the prior art. Therefore, the prior art cited above meets the limitations of the claims.

With regard to claim 4, Sato discloses that the connector line may comprise two notches formed in opposing sides of the second end (see 22b in FIG 6).

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,963,131 to Wortrich in view of US 4,416,772 to Sato et al, further in view of US 4,930,997 to Bennett.

In the specification and figures, Wortrich and Sato disclose the device substantially as claimed by Appellant (see rejection above), but are silent as to the manner in which the connector and the bag are sealed together.

Bennett discloses a medical suction apparatus with a collection tube 23 that connects suction device 20 to reservoir bag 120 (see FIG 1). The collection tube is heat sealed to collection bag 120 via sealing seam or ring 123 in order to create a tight seal without risk of liquid leakage (see column 15, lines 1-10). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to seal the connector tubes and collection bags disclosed by Wortrich and Sato via a heat seal with a sealing ring as disclosed by Bennett in order to create a seal without risk of liquid leakage, as taught by Bennett.

(10) Response to Argument

Appellant argues that the Wortrich patent teaches fluid venting, and not air venting. It is the position of the Examiner that unless defined elsewhere, air is a fluid. Accordingly, the Wortrich reference does not teach away from the presently claimed structure. Appellant contends that one of ordinary skill in the art reading the Wortrich patent would not be concerned with the fitments of the waste bag 100. However, Wortrich discloses that waste bag 100 collects aspirant from the surgical field, creating

suction in the surgical field. If the waste bag 100 were to collapse around the fitment, it is possible that the collapse would generate too much suction in the surgical field (the eye), causing eye collapse. Accordingly, one of ordinary skill in the art would be concerned with methods and devices to prevent excess suction to the surgical field.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., venting air during a surgical procedure) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant's claim language directed to the movement of air during the procedure is considered by the examiner to be a statement of the intended use of the claimed invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See MPEP 2114. In the instant case, the structural limitations of the claimed invention are met by the prior art as discussed above. Air, as a gas, is a type of fluid. As such, a device that is disclosed as being a fluid venting device is capable of venting air, which is a fluid. Therefore, the prior art devices are capable of performing the intended use, thereby meeting the limitations of the claims.

Applicant argues that the references are not properly combined by the examiner, since one of ordinary skill in the art of ophthalmic surgery venting, as disclosed by

Art Unit: 3761

Wortrich, would not consider the fluid handling system disclosed by Sato to remedy the problem solved by the instant invention. Applicant specifically argues that the instantly claimed invention is directed to air venting, while the Wortrich and Sato inventions are concerned with fluid venting. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24

USPQ2d 1443 (Fed. Cir. 1992). In this case, both the Wortrich and Sato devices are concerned with controlling the movement of fluid (which may include air) in a confined path. Applicant's invention is directed to providing a conduit for aspirant to flow to a collection bags as well as providing for fluid movement of air through the system. Since the prior art and the instant invention provide solutions for the problems of directing fluid flow, the art is pertinent to the applicant's invention and properly combined to reject applicant's invention.

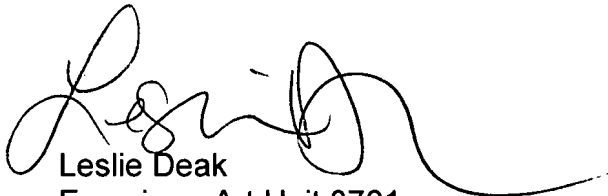
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 3761


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Leslie Deak
Examiner, Art Unit 3761

Conferees:



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